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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/338,729      | 06/23/1999  | DENNIS GROSS         | 10853/1             | 1761             |

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 76-78, 85, 88, 90-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 11-15,28,29,33-36,40,43,44,47,49,50,70,72,73,76-78,85,88 and 90-117.

### **DETAILED ACTION**

Receipt is acknowledged of response filed on February 5, 2005. Claim rejections made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated December 1, 2004, are maintained for the reasons of record. Claim objection is withdrawn in view of claim amendment. Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 76-78, 85, 88, 90-117 are pending.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. **Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 77-78, 85, 88, 90-99, 101-106, and 109-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5720949) in view of Rapaport (US 5505948).**

Rejection is maintained for the reasons of record.

2. **Claims 76, 100, 107, and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis and Rapaport as applied to claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70, 72, 73, 77-78, 85, 88, 90-99, 101-106, and 109-117, and further in view of Linn et al. (US 4797273), Hahn et al. (US 5804203), and McAtee et al. (US 5811111).**

Rejection is maintained for the reasons of record.

#### ***Response to Arguments***

Applicant's arguments filed on February 5, 2005 have been fully considered but they are not persuasive.

As applicants have correctly pointed out the issue in this case whether one of skilled art would have been motivated to use the Rapaport skin peeling acidic composition in the Davis method, and apply a moisturizer, sun screen and/or makeup when the acidic and effervescent compositions still remain on the skin, or without having been rinsed off from the skin.

The motivation is found in the collective teachings of the references. The Davis reference in col. 11, lines 40 – 50 states, there teaches that maintaining an acidic composition on the face of the consumer following complete reaction if “gentle peel of the skin is desired”. How much excess of acid component over the effervescent agent, or the neutralizing agent, should be present in the composition is also specified – the initial concentration of the gel activator should be in excess of 20 % by weight. Rapaport teaches a composition for “gentle peel” acidic composition in low concentration. Thus it would have been obvious to a skilled artisan to look to Rapaport for specific formulation for gentle peel compositions.

Applicants point to the teaching in Rapaport that the prior art acidic composition is “intended to be left upon the skin of the user without the neutralization or removal required in the prior art”, and argue that there is no motivation to neutralize the Rapaport acidic composition applied to the skin. Examiner respectfully submits that the argument is not persuasive because the complete teaching of reference in fact suggests that the need of neutralization or removal depends on the concentration of the peeling acid. The reference recites, “Because the peeling composition of the present invention is of low concentration and is thus medically effective in preventing skin wounding which

is perceptible, the composition of the present invention may be, and is intended to be left upon the skin of the user without the neutralization or removal required in the prior art." The reference in col. 11, line 8 – 29 also teaches,

the present invention can be left on the skin due [to] its low concentration of gentle peeling agents. . . . In contrast, the prior art requires the application followed by the relatively quick neutralization or removal of peeling agents. This quick removal or neutralization is **obviously necessary** due to the high concentrations of peeling agents used in the prior art, with their attendant harshness and action deep within the skin and the wounding of living skin tissue.

It is the low concentration of the alpha-hydroxy acid in the composition which allows the peeling composition to be left on the skin, and this is also what Davis teaches is useful for gentle peeling. Neutralization **is** a required step, however, according to Rapaport, in cases where a high concentration of peeling agents is used. It is noted that claims 40, 77, 78, 104, and 117 require up to 45 % of alpha-hydroxy or beta hydroxyl acids used in the formulation, while claim 90 merely requires a highly acidic (pH 2.5 -4) component in the first liquid composition. Thus, it is obvious that a skilled artisan would have designed a skin peel regime with a neutralization step if a higher concentration of skin peeling agents were used.

Furthermore, while Rapaport teaches that its invention which does not need removal or neutralization step as an improvement over the prior art, the reference nonetheless teaches that the skin peeling regime with a neutralization step is old and well known in cosmetic art. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition

does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In this case, both Davis and Rapaport teach that a method of skin peeling which requires a neutralization step is old and well known, and such method does not become patentable simply because a new method of eliminating the neutralization step has been known. The Rapaport method in which the neutralization step is not needed is specifically limited to cases where low acid concentration is used. While applicants argue that Davis' effervescent composition would stop the skin-peeling action of Rapaport's composition, Rapaport teaches that neutralization is necessary to protect the skin from a harsh acidic environment.

The choice of vehicle for a composition that remains on the skin is obviously suggested in both Davis and Rapaport. It is well known in the art, according to Davis, that lotion or cream type of compositions are generally massaged into the skin and not removed. Rapaport also teaches specific liquid formulations that applicants claim. In view of the combined teachings of the references, the claimed gentle skin peel regime which allows the acidic composition to remain on the skin after complete reaction of the acid and effervescent component in the form of lotion would have been obvious to the routineer at the time of the present invention. The motivation to modify the mask composition into a less viscous formulation is to make a composition that can remain on the skin after the application, as taught by these references.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

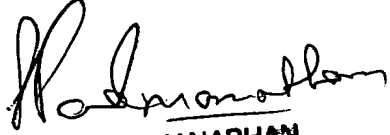
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**